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AMIN, TUROCY & CALVIN, LLP			EXAMINER	
24TH FLOOR, NATIONAL CITY CENTER			PEARSON, DAVID J	
1900 EAST NINTH STREET				
CLEVELAND, OH 44114			ART UNIT	PAPER NUMBER
			2137	
			NOTIFICATION DATE	DELIVERY MODE
			08/18/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/729,798

Applicant(s)

HIRST, ROY

Examiner

DAVID J. PEARSON

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Claims 1, 5-6, 11, 16 and 20-21 have been amended. Claims 1-17 and 20-25 have been examined.

Response to Arguments

2. Applicant's arguments, filed 08/04/2008, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Shen et al. (U.S. Patent Application Publication 2003/0149890).

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

4. Claims 1, 5-6, 8-16 and 20-21, are rejected under 35 U.S.C. 102(e) as being anticipated by Shen et al. (U.S. Patent Application Publication 2003/0149890; hereafter referred to as "Shen").

For claims 1, 11 and 16, Shen teaches a method and computer readable storage medium of storing digitally encoded material, the method comprising:

Associating a unique identifier with digitally encoded material (note paragraph [0064]); and

Associating one or more built-in functions (note paragraph [0085]) with digitally encoded material such that the unique identifier and the built-in functions are coupled to the digitally encoded material (note paragraph [0034]); and

Rendering or transforming the digitally-encoded material based on the built-in functions (note paragraph [0094]), wherein the digitally-encoded material can be transformed and rendered only by the built-in functions (note paragraph [0017]).

For claims 6 and 21, Shen teaches a method and computer readable medium for tracking digitally encoded material, the method comprising:

Appending a unique identifier to the digitally encoded material (note paragraph [0064]);

encrypting a combination including the digitally encoded material and the unique identifier (note paragraph [0034]); and

appending built-in function source code (note paragraph [0085]) and the encrypted combination to form an executable entity (note paragraph [0037]) capable of being executed independent of a particular operating system (note paragraph [0015]), wherein the digitally-encoded material can be transformed and rendered only by the built-in functions (note paragraph [0017]); and

including at least an encryption (note paragraph [0015]) and decryption function with the built-in function source code (note paragraph [0032]).

For claims 5, 12 and 20, Shen teaches claims 1, 11 and 16 **further including an encrypt function** (note paragraph [0015]) **and a decrypt function** (note paragraph [0032]) the built-in functions that enables the digitally encoded material to be stored in RAM in an encrypted form (note paragraph [0094]).

For claims 8 and 13, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 6 and 11 wherein the built-in functions include rendering functions (note paragraph [0094]) and transform functions (note paragraph [0032]).

For claims 9 and 14, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 8 and 13 wherein the rendering functions include one or more of a close, find shape, full screen, go to guide, help, open (note paragraph [0094]), order pan, properties, reveal, rotate/flip, search, select, size, and position, spell check or zoom.

For claims 10 and 15, the combination of Rabinovitch, Matsuyama and Friedman teaches claims 8 and 13 wherein the transform function include one or more of copy, DRM agent (note paragraph [0032]), export, insert, log, new, paste, print, replace, or save as.

Claim Rejections - 35 USC § 103

5. Claims 2-3, 17 and 22-23, 17 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen et al., and further in view of Matsuyama et al. (U.S. Patent 6,574,611, hereafter "Matsuyama").

For claims 2-3 and 17, Shen differs from the claimed invention in that they fail to teach:

Associating a history of the digitally encoded material with the digitally encoded material, wherein the history being located in a database.

Matsuyama teaches:

Associating a history of the digitally encoded material with the digitally encoded material (note column 23, lines 52-56), wherein the history being located in a database (note column 23, lines 11-21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the IPMP tools of Shen and the usage history of Matsuyama. One of ordinary skill in the art at the time of the invention would have been motivated to combine Shen and Matsuyama because it would provide a way for content providers to be compensated based on the usage of the content (note column 11, line 55 through column 12, line 8 of Matsuyama).

For claim 22, the combination of Shen and Matsuyama teaches claim 21 wherein the acts further comprise:

tracking the digitally encoded material by maintaining an auditable document history log (note column 23, lines 52-56 of Matsuyama).

For claim 23, the combination of Shen and Matsuyama teaches claim 22 wherein the auditable document history log is maintained in one of a file associated with the digitally-encoded material and a database independent of the digitally-encoded material (note column 23, lines 11-21 of Matsuyama).

6. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen as applied to claims 1 and 6 above, and further in view of Rabinovitch (U.S. Patent Application Publication 2006/0101521).

For claims 4 and 7, Shen differs from the claimed invention in that they fail to teach:

wherein the built-in function includes one or more of Copy, Paste or Print.

Rabinovitch teaches:

wherein the built-in function includes one or more of Copy, Paste or Print (note paragraph [0047]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the IPMP tools of Shen and the copy and print control functions of Rabinovitch. One of ordinary skill in the art would have been motivated to combine Shen and Rabinovitch because it would increase the management of the digital content by allowing control over copying and printing of the content.

7. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shen, Matsuyama and Rabinovitch as applied to claim 10 above, and further in view of Nelson (U.S. Patent 6,691,229).

For claim 24, the combination of Shen, Matsuyama and Rabinovitch differs from the claimed invention in that they fail to teach:

Including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated copy of the digitally encoded material such that the copy comprises the unique identifier and the second unique identifier.

Nelson teaches:

Including the copy function in the transform functions wherein upon executing the copy function a second unique identifier is generated and appended to a generated copy of the digitally encoded material such that the copy comprises the unique identifier and the second unique identifier (note column 7, line 57 through column 8, line 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the combination of Shen, Matsuyama and Rabinovitch with the enforcement data of Nelson. One of ordinary skill in the art at the time of the invention would have been motivated to combine Shen, Matsuyama, Rabinovitch and Nelson because it would allow unauthorized copies of content to be traced to the person who accepted the original (note column 4, lines 38-42 of Nelson).

For claim 25, the combination of Shen, Matsuyama, Rabinovitch and Nelson teaches claim 24, wherein executing the copy function updates document history of the digitally encoded material and the generated copy (note column 23, lines 52-56 of Matsuyama) and informs at least an author of the digitally encoded material of the generated copy (note column 9, lines 31-39; 57-61 of Matsuyama).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. PEARSON whose telephone number is (571)272-0711. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm; off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJP

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2137